



PATENT APPLICATION

Docket: 6300.103

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
)
McClane et al.)
)
Serial No. 10/040,883) Art Unit
) 3737
Confirmation No. 8869)
)
Filed: January 7, 2002)
)
For: METHOD AND APPARATUS FOR RAMAN)
IMAGING OF MACULAR PIGMENTS)
)
Examiner: Baisakhi Roy)
)
Customer No. 022913)

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Declarant, Rajiv Kulkarni, represents that he is the Senior Licensing Manager of The University of Utah Research Foundation, a non-profit corporation of the State of Utah, having a principal place of business at 615 Arapeen Drive, Suite 110, Salt Lake City, Utah 84108, and that he is authorized to make this Declaration and execute this Terminal Disclaimer on behalf of The University of Utah Research Foundation. Declarant further represents that The University of Utah Research Foundation is the assignee of the entire interest, as shown by the Assignment from The University of Utah recorded at reel 8493, frame 0784 (a copy of which is attached

hereto as Exhibit A) in the records of the U.S. Patent and Trademark Office, of the above-identified application. The University of Utah was the assignee of the entire interest, as shown by the Assignment from each of the inventors recorded at reel 8493, frame 0811 (a copy of which is attached hereto as Exhibit B) in the records of the U.S. Patent and Trademark Office, of the above-identified application.

Declarant hereby further certifies that the evidentiary documents at Exhibits A and B have been reviewed by him/her, and to the best of the Declarant's knowledge and belief, title is in the Assignee seeking to take action.

The Assignee hereby disclaims the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of said U.S. Patent No. 5,873,831 and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to said U.S. Patent No. 5,873,831, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

The Assignee does not disclaim any terminal part of any patent granted on the above-identified application that would extend beyond the term of said U.S. Patent No. 5,873,831 in the event that said U.S. Patent No. 5,873,831 later: (a) expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a); (b) has all claims cancelled by a reexamination certificate; or (c) is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Declarant further declares that all statements made herein of Declarant's own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful, false statements may jeopardize the validity of the application or any patent issuing thereon.

DATED this 21 day of March 2005.

THE UNIVERSITY OF UTAH
RESEARCH FOUNDATION

By:

R.K. Kulkarni

Name: R. K. KULKARNI

Title: Sr. LICENSING MGR.

DFR0000007578V001



JUNE 19, 1997



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

PTAS

WORKMAN, NYDEGGER & SEELEY
DAVID O. SEELEY
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111



100415507A

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

RECORDATION DATE: 05/08/1997

REEL/FRAME: 8493/0784
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

UTAH, UNIVERSITY OF, THE

DOC DATE: 04/24/1997

ASSIGNEE:

UNIVERSITY OF UTAH RESEARCH FOUNDATION, THE
421 WAKARA WAY, SUITE 170
SALT LAKE CITY, UTAH 84108

SERIAL NUMBER: 08815936
PATENT NUMBER:

FILING DATE:
ISSUE DATE:

JACQUELINE MOORE, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

REL

05-13-1997

SHEET

U.S. DEPARTMENT OF COMMERCE

Patent and Trademark Office

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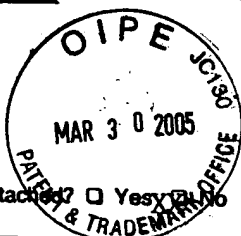
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MAY 08 1997

To the Honorable Commissioner of Pa

ached original documents or copy thereof

1. Name of conveying party(ies):
The University of Utah

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment☐ Merger☐ Security Agreement☐ Change of Name☐ Other _____

Execution Date: April 24, 1997

2. Name and address of receiving party(ies)

Name: The University of Utah Research
Foundation

Internal Address: _____

Street Address: 421 Wakara Way, Suite 170

City: Salt Lake City State: Utah ZIP: 84108

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

Serial No. 08/815,936

Filed March 13, 1997

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

David O. Seeley

Name: Workman, Nydegger & Seeley

Internal Address: _____

Street Address: 60 East South Temple

1000 Eagle Gate Tower

City: Salt Lake City State: Utah ZIP: 84111

6. Total number of applications and patents involved:

7. Total fee (37 CFR 3.41).....\$ 40.00

☒ Enclosed☐ Authorized to be charged to deposit account

8. Deposit account number:

23-3178

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

David O. Seeley

Name of Person Signing

Signature

5 May 1997

Date

Total number of pages including cover sheet, attachments, and document:

3

Workman, Nydegger & Seeley
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111

ASSIGNMENT

Whereas, The University of Utah, an institution of higher education of the State of Utah, having a place of business at 421 Wakara Way, Suite 170, Salt Lake City, Utah 84108, is the owner of the entire right, title and interest in and to application for United States Letters Patent entitled METHOD AND SYSTEM FOR MEASUREMENT OF MACULAR CAROTENOID LEVELS, Serial No. 08/815,936 filed March 13, 1997 in the names of Paul S. Bernstein, Werner Gellermann and Robert W. McClane.

Whereas, The University of Utah Research Foundation, a nonprofit corporation of the State of Utah, having a place of business at 421 Wakara Way, Suite 170, Salt Lake City, UT 84108, is desirous of acquiring the entire right, title and interest in and to the said invention within the United States of America and its territorial possessions and within the countries foreign to the United States and any United States or foreign Letters Patent that may be granted therefor; and in and to said application;

Now, therefore, in consideration of the sum of One Dollar (\$1.00) paid by The University of Utah Research Foundation to the University of Utah and other good and valuable considerations, the receipt of which is hereby acknowledged, The University of Utah has sold, assigned and transferred and by these presents does hereby sell, assign and transfer unto said University of Utah Research Foundation the entire right, title and interest in and to the said invention within the United States of America and its territorial possessions and within all countries foreign to the United States

and in and to any United States or foreign Letters Patent that may be granted therefor and in and to the said application and in and to any and all divisions, reissues, continuations and extensions thereof and in and to any Letters Patent that may be granted thereon, all said rights to be held and enjoyed by The University of Utah Research Foundation for its own use and enjoyment and for the use and enjoyment of its successors and assigns to the full end of the term or terms for which said Letters Patent may be granted as fully and entirely as the same would have been held and enjoyed by The University of Utah if this assignment, transfer and sale had not been made.

The University of Utah hereby authorizes and requests the United States Commissioner of Patents and Trademarks and all authorized officials of foreign patent offices to issue the said Letters Patent, when granted, to said University of Utah Research Foundation as the assignee of its entire right, title and interest in and to the same, for the sole use and enjoyment of said University of Utah Research Foundation, its successors and assigns.

In Testimony Whereof, The University of Utah has caused the hand of its proper representative to be subscribed hereto this 24th day of April, 1997.

THE UNIVERSITY OF UTAH

By 
Christina Jansen
Director of Technology Transfer



JUNE 19, 1997



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

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DAVID O. SEELEY
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1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111



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RECORDATION DATE: 05/08/1997

REEL/FRAME: 8493/0811
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
BERNSTEIN, PAUL S.

DOC DATE: 03/13/1997

ASSIGNOR:
GELLERMANN, WERNER

DOC DATE: 03/13/1997

ASSIGNOR:
MCCLANE, ROBERT W.

DOC DATE: 03/13/1997

ASSIGNEE:
UTAH, UNIVERSITY OF
421 WAKARA WAY, SUITE 170
SALT LAKE CITY, UTAH 84108

SERIAL NUMBER: 08815936
PATENT NUMBER:

FILING DATE:
ISSUE DATE:

8493/0811 PAGE 2

MAYA BENNETT, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

Docket No: 6300.66

Workman, Nydegger & Seeley
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111

ASSIGNMENT

We, Paul S. Bernstein, Werner Gellermann and Robert W. McClane, of 6633 South Old Mill Circle, Salt Lake City, Utah 84121; 1360 East Kensington, Salt Lake City, Utah 84105; and, 484 North H Street, Salt Lake City, Utah 84103, respectively, have invented a method and apparatus entitled METHOD AND SYSTEM FOR MEASUREMENT OF MACULAR CAROTENOID LEVELS hereinafter called the "invention."

Preferred embodiments of said invention are disclosed in a United States patent application executed concurrently herewith by us and now identified as File No. 6300.66 of the law firm of Workman, Nydegger & Seeley, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, Utah 84111, and filed in the United States Patent and Trademark Office as Serial No. 08/815,936 on March 13, 1997. (We hereby authorize the attorneys of Workman, Nydegger & Seeley to insert said serial number and filing date when known.)

The Assignee, The University of Utah, an institution of higher education of the State of Utah, having a principal place of business at 421 Wakara Way, Suite 170, Salt Lake City, UT 84108, desires to secure the entire right, title and interest in said invention.

In consideration of One Dollar (\$1.00) and other good and valuable consideration paid to us by the Assignee, the receipt and sufficiency of which we hereby acknowledge, WE HEREBY ASSIGN TO THE ASSIGNEE:

The entire right, title and interest in said invention in the above-identified United States patent application and in all divisions, continuations and continuations-in-part of said application, or reissues or extensions of Letters Patent or Patents granted thereon, and in all corresponding applications filed in countries foreign to the United States, and in all patents issuing thereon in the United States and foreign countries.

The right to file foreign patent applications on said invention in its own name, wherever such right may be legally exercised, including the right to claim the benefits of the International Convention for such applications.


We hereby authorize and request the United States Commissioner of Patents and Trademarks, and such Patent Office officials in foreign countries as are duly authorized by their patent laws to issue patents, to issue any and all patents on said invention to the Assignee as the owner of the entire interest, for the sole use and behalf of the said Assignee, its successors, assigns and legal representatives.

We hereby agree, without further consideration and without expense to us, to sign all lawful papers and to perform all other lawful acts which the Assignee may request of us to make this Assignment fully effective, including, by way of example but not of limitation, the following:


Prompt execution of all original, divisional, substitute, reissue, and other United States and foreign patent applications on said invention, and all lawful documents requested by the Assignee to further the prosecution of any of such patent applications.

Cooperation to the best of our ability in the execution of all lawful documents, the production of evidence, nullification, reissue, extension, or infringement proceedings involving said invention.


Dated this 16 day of June 1999.


Werner Gellermann
1360 E. Kensington
Salt Lake City, UT 84105

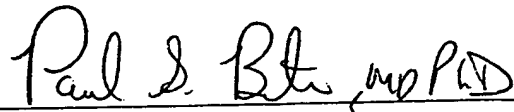
Dated this 16 day of JUNE 1999.


Robert W. McClane
484 H Street
Salt Lake City, UT 84103

Dated this 16 day of June 1999.


Nikita B. Katz
732 South 400 East, #206
Salt Lake City, UT 84111

Dated this 17 day of June 1999.


Paul S. Bernstein
6633 Old Mill Circle
Salt Lake City, UT 84121